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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,465	06/22/2001	Edward B. Nelson	MCP-267	6932

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EXAMINER

TRAVERS, RUSSELL S

ART UNIT PAPER NUMBER

1617

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/887,465

Applicant(s)

Nelson et al

Examiner

R.S. Travers J.D., Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 7, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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The election filed November 7, 2002 has been received and entered into the file.

Claims 1-26 are presented for examination.

Applicant's election with traverse of Group I, directed to methods for treating atherosclerotic conditions in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the number of species is limited. This is not found persuasive because the restriction was based on the distinction between methods of use and compositions of matter.

The requirement is still deemed proper and is therefore made FINAL.

Claims 20-23 reading on compositions of matter are withdrawn from consideration. Examiner apologizes for the inadvertent inclusion of claim 20 in the method of use group, this claim is directed to a composition of matter and thus, would be non-elected as not reading on the elected subject matter.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

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The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art
- 7) the predictability of the art, and
- 8) the breadth of the claims.

Applicant fails to set forth the criteria that defines antioxidants or "filtrates" useful as treating coronary disease". Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these compounds without undue experimentation. In the instant case, only a limited number of antioxidants or "filtrates" examples are set forth, thereby failing to provide sufficient working examples. It is noted that these examples are neither exhaustive, nor define the class of compounds

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required. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all antioxidants or "filtrates", necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

In the instant case, Applicants place an undue quantity of experimentation on the skilled artisan. To practice the invention as claimed the skilled artisan must undertake experimentation to ascertain if compounds identified in the prior art as antioxidants or "filtrates" are suitable for practicing the invention as claimed. In the instant specification Applicants failed to provide any direction or guidance as to what criteria the skilled artisan would employ to ascertain those antioxidants or "filtrates" possessing the required therapeutic properties. The anti-atherosclerotic prior art teaches treatment of the claimed conditions as unpredictable, thus, failing to provide proper guidance for the skilled artisan.

Additionally, Applicant fails to set forth the treatment regimens providing prevention of arteriosclerosis, or regression of arteriosclerosis. Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these therapeutic regimens without undue experimentation. Applicants provide no prevention of arteriosclerosis, or regression of arteriosclerosis examples, thereby failing to provide sufficient working examples. The pharmaceutical art is unpredictable, requiring each

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embodiment to be individually assessed for physiological activity. The instant claims read complete prevention of arteriosclerosis, or regression, or cure, of arteriosclerosis situations neither illustrated, or discussed in the instant specification. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

Claims 23--26 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2 and 23-26 are rejected under 35 U.S.C. § 102(a) as being anticipated by Taylor et al.

Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from inherent use, absent a *haec verba* recitation for such utility. In the instant application, as in *Ex parte Novitski*, supra, the claims are directed to preventing a malady or disease with old and well known compounds or compositions. It is now well settled law that administering compounds inherently possessing a protective utility anticipates claims directed to such protective

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use. Arguments that such protective use is not set forth *haec verba* are not probative. Prior use for the same utility clearly anticipates such utility, absent limitations distancing the proffered claims from the inherent anticipated use. Attempts to distance claims from anticipated utilities with specification limitations will not be successful. At page 1391, *Ex parte Novitski*, supra, the Board said "We are mindful that, during the patent examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 219 (CCPA 1975)". In the instant application, Applicants' failure to distance the proffered claims from the anticipated prophylactic utility, renders such claims anticipated by the prior inherent use.

The following is a quotation of 35 U.S.C. § 103, which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed

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invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-19 and 23-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Taylor et al, Morehouse, Pick et al and Sun et al

Taylor et al, Morehouse, Pick et al and Sun et al teach the acetaminophen, atorvastatin (claim 18), aspirin, vitamin C and vitamin E respectively as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. These medicaments are taught as useful for treating arteriosclerosis, viewed by the skilled artisan as the condition herein claimed. Claims 3-19, and the primary references, differ as to:

- 1) the concomitant employment of these medicaments.

It is generally considered prima facie obvious to combine two, or more, compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional anti-atherosclerosis agents. It would follow that the recited claims define prima facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).



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Claims 24 and 26 specifically require a defined dose. Taylor et al teach employment of the claimed compound in an oral form, at a rate not exceeding 50 mg/kg, meeting the instant dosage rate. The skilled artisan would have seen all conventional compositions, and the administration of these compositions by conventional means as residing in the skilled artisan purview.

No claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.



**Russell Travers  
Primary Examiner  
Art Unit 1617**